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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,715	06/28/2006	Hyue-Jin Lee	P58024	8575
8439	7590	12/03/2009	EXAMINER	
ROBERT E. BUSHNELL & LAW FIRM			MEHTA, HONG T	
2029 K STREET NW			ART UNIT	PAPER NUMBER
SUITE 600			1794	
WASHINGTON, DC 20006-1004				
NOTIFICATION DATE		DELIVERY MODE		
12/03/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/581,715	<b>Applicant(s)</b> LEE, HYE-JIN
	<b>Examiner</b> HONG MEHTA	<b>Art Unit</b> 1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 12 August 2009.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-4 and 8-20 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-4 and 8-20 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/GS-68)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

This office action is in response to applicant's remarks filed on August 12, 2009.

Pending amended claim 1-4, and 8-20 are under examination. Claims 13-20 are new claims.

### ***Specification***

The specification is objected to. The specification does not conform to standard practice in the US. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

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### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).

- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

The specification is replete with terms which are not clear, concise and exact. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. It appears that this specification may be a translation of foreign language application. The specification should be amended to contain clear and grammatically correct English.

The abstract is objected to. Applicant is reminded of the proper language and format for an abstract of the disclosure. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 1-4 and 8-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

3. Claim 1 recites the limitations "the egg shell", and "the long axis," in steps b and d. There is insufficient antecedent basis for these limitations in the claim.

4. The term "in situ natural" in claims 1 and 8, is a relative term which renders the claim indefinite. The term "in situ natural" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The definition of "in situ" as defined by the Merriam-Webster dictionary, in the natural or original position or place. It is unclear the process of making a raw material with edible composition is still natural if the claimed invention is drawn to adding the addition of edible ingredients, such as spices and vitamins. Please clarify.

5. Claim 8 recites the limitations "the contents" in Line 4. There is insufficient antecedent basis for this limitation in the claim.

6. Claim 9 recites the limitation "the egg shell" in Line 2. There is insufficient antecedent basis for these limitations in the claim.

7. Regarding claims 3, 14, 19 and 20, the terms "certain thickness" in claim 3, and "thickness of albumen closest to the egg-shell" in claim 14, 19 and 20, are relative terms

which renders the claim indefinite. The term "certain thickness" and thickness of albumin closest to the egg-shell" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. One of ordinary skill in the art would not know how thick the albumin should be. The examiner has treated these terms to mean any thickness.

8. Regarding claim 2, the phrase "and/or" renders the claim indefinite because it is unclear whether the limitation(s) surrounding the phrase are part of the claimed invention. See MPEP § 2173.05(d). The examiner has treated the movement of the agitator to be rotational or upwards and downwards.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. **Claims 1-3, 8-11 and 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hongqi (CN Pub. No. 1209299) in view of Hebrank (US Pat. No. 6244214) and Hansen (US Pat No. 2316861) and CFR Title 21 Part 110 (FDA, Good Manufacturing Practice in Manufacturing, Packing, or Holding Human Food).**

13. **Regarding claims 1 and 2,** Hongqi teaches boiling an egg that has had a flavoring injected into it. The examiner treats boiling as being equivalent to the step of leaning and sterilizing since it is well known that boiling water (high heat) is an effective means of cleaning and sterilization.

14. Hongqi further teaches using an injector to inject liquid flavoring material through an egg shell (Hongqi Abs.). Hongqi does not teach that the egg is fixedly erected or that the injection hole is formed on the end of the long axis. However, it is known to hold an egg in an erect position and inject material through a hole formed at the end of the long axis.

15. Hebrank teaches holding an egg in a erect position and inserting an injection tube into the end of the long axis of an egg (Hebrank Fig 2; Col. 8, Line 60 - Col. 9, Line 8; Col. 9, Lines 40-44; the figure shows the orientation of the egg and the injector (25) above it, the injector is in the form of a needle or syringe with an outer guide to pierce the shell of the egg). It would have been obvious to a person of ordinary skill in the art at the time of invention to have modified the injection step taught in Hongqi with the injection taught by Hebrank to effect an injection at the end of the long axis of an egg shell and deliver material to the interior portion of an unshelled egg. The person of ordinary skill in the art at the time of invention would have been motivated to do so since this is an effective method of injecting material into an egg as it gives the ability to inject material into a specific location within the egg and holds the egg stable while being injected (Hebrank Col. 4, Lines 19-28; Col. 8, Lines 61-65).

16. Hongqi teaches mixing the injected contents and the interior contents of an egg by shaking but does not say how that it is accomplished. Agitators for mixing the interior contents of an egg are known in the art. Hansen teaches an egg beater which mixes the interior portion of an egg by inserting an agitator through a hole at the end of the long axis of an egg at which time springs (17) extend from the blade (16) (Hansen Figs. 1 and 2; Col. 2, Lines 15-26). It would have been obvious to a person of ordinary skill in the art at the time of invention to have performed the mixing taught by Hongqi with the agitation taught by Hansen as Hansen clearly teaches an effective agitation technique that allows the contents of the egg within the shell to remain contained therein (Hansen Col. 1, Lines 4-5).

**17. Regarding claim 3 and 14,** as shown by Hongqi (Abs.) it is known that heating causes the contents of an egg to coagulate. Furthermore, Hongqi teaches coagulating at the hole prior to cooking (Abs.) which, the examiner treats as equivalent to solidifying a certain thickness inwards of the shell. Since it is well known that heat causes an egg to coagulate, it would have been obvious to have performed this step at any point during the process. The motivation to do so would have been to create a final product with desired characteristics such as a desired ingredient distribution or consistency.

**18. Regarding claims 8-11,** the products taught therein are obvious for the same reasons that the methods of claims 1-3 are obvious as the product is largely defined by the methods already discussed above. There are certain exceptions as outlined below.

**19. Regarding claim 10, 15, and 16,** the references used herein do not teach how much of an edible composition may or may not be added to the egg shell. However, the methods taught by Hebrank would allow the person of ordinary skill in the art to add as much or as little material as desired. It therefore would have been obvious to a person skilled in the art at the time of invention to have added no more than 10% of the volume of the egg to the egg shell to form an egg that has desirable characteristics such as consistency and flavor.

**20. Regarding claim 11,** Hongqi teaches that flavorings are added (Abs.). Flavorings are considered an edible spice. Additionally, it would have been obvious to one of ordinary skill to inject any known flavoring (considered an edible material) whether natural or man made for the purpose of adding desired flavoring to the egg product.

**21.** Regarding claim 17, 18 and 19, Hongqi teaches that flavorings are added (Abs.). Flavorings are considered an edible spice, vitamins, edible pigments and flavors such as sugar, salt, and pepper. Additionally, it would have been obvious to one of ordinary skill to inject any known flavoring (considered an edible material) whether natural or man made for the purpose of adding desired flavoring to the egg product.

**22.** The references used herein do not teach how much of an edible composition may or may not be added to the egg shell. However, the methods taught by Hebrank would allow the person of ordinary skill in the art to add as much or as little material as desired. It therefore would have been obvious to a person skilled in the art at the time of invention to have added no more than 10% of the volume of the egg to the egg shell to form an egg that has desirable characteristics such as consistency and flavor.

**23.** Additionally, with respects to the amount of adding no more than 10% of edible materials, such as vitamins, edible spices, edible pigments, carbohydrates, grains or fruit to the volume of egg. Attention is invited to *In re Levin*, 84 USPQ 232, and the cases cited therein, which are considered in the point in the fact situation of the instant case, and wherein the Court sates on page 234 as follows:

**24.** This court has taken the position that new recipes or formulas for cooking food which involve the addition of elimination of common ingredients or for treating them in a ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further

establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected, and useful function. *In re Benjamin D. White*, 17 C.C.P.A. (Patents) 956, 39 F.2d 974, 5 USPQ 267; *In re Mason et al.*, 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ221.

**25. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hongqi (CN Pub. No. 1209299), Hebrank (US Pat. No. 6244214) and Hansen (US Pat No. 2316861) as applied to claims 1 above and further view of CFR Title 21 Part 110 (FDA, Good Manufacturing Practice in Manufacturing, Packing, or Holding Human Food).**

26. Hongqi, Hebrank and Hansen disclose the claimed invention as discussed in claim 1. Hongqi does not suggest to a cleaning and sterilizing step before forming an injection hole. However, it is well known in the art of manufacturing that Good Manufacturing Practice Regulations under the authority of Federal Food, Drug and Cosmetic Act (p. 214-215) to ensure sanitation and cleanliness to minimize or eliminate contamination in raw material food ingredients, such as egg. It would have been obvious to one of ordinary skill in the art to ensure the raw material, egg is cleaned and sterilized before further processing raw materials, since it is a known and regulated practice in the food industry.

**27. Claims 4, 12, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hongqi (CN Pub. No. 1209299) in view of Hebrank (US Pat. No. 6244214) and Hansen (US Pat No. 2316861) as applied to claims 1 and 8, above, and further in view of Chikako (JP 61-141864).**

28. Hebrank teaches that the device taught therein can be used to add or withdraw contents to or from eggs (Col. 3, Line 67). Additionally, it is known in the art to withdraw contents including albumin and/or yolk followed by addition of edible material to the shell of the egg through a hole in the shell (Chikako JP Pub. No. 61-141864). Given the teachings of Hongqi and Hebrank as outlined above, it would have been obvious to a person of ordinary skill in the art at the time of invention to have used the injector/extractor as taught by Hebrank to execute the invention of Chikako. The motivation to have done so would have been to prepare a boiled egg containing a food material different from the egg components using known techniques and apparatus to perform the steps (Chikako, Abs.).

29. Furthermore, Hongqi teaches the addition of flavorings to an egg (Hongqi abs.), a person of ordinary skilled in the art at the time of invention would have realized that flavorings would include a sweetener such as sugar which is a carbohydrate. Flavorings are considered an edible spice, vitamins, edible pigments and flavors such as sugar, salt, and pepper. Additionally, it would have been obvious to one of ordinary skill to inject any known flavoring (considered an edible material) whether natural or man made for the purpose of adding desired flavoring to the egg product.

***Response to Arguments***

30. Applicant's arguments filed August 12, 2009 have been fully considered but they are not persuasive. Applicant amended claims 1-4, and 8-12 and add new claims 13-20.

31. Applicant states that a substitute specification was filed with the amendment, however, no substitute specification has been received, and therefore, the objections are maintained.

32. In response to applicant's argument with regards to amended claims 1-3 and 8-10, that '861 Hansen cannot not be properly combined with '299 Hongqi because the method of '861 Hansen discloses mixing with the egg beater, then breaking the egg and removing the scrambled contents of the egg from the egg shell.

33. Examiner notes '861 Hansen is relied upon for the teaching of Hansen teaches an egg beater which mixes the interior portion of an egg by inserting an agitator through a hole at the end of the long axis of an egg at which time springs (17) extend from the blade (16) (Hansen Figs. 1 and 2; Col. 2, Lines 15-26). Hansen clearly teaches an effective agitation technique that allows the contents of the egg within the shell to remain contained therein ('861, Col. 1, Lines 4-5). In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to a person of ordinary skill in the art at the time of invention to have performed the shaking taught by Hongqi with the agitation taught by Hansen to properly mix the flavorings with the egg content within the

egg shell. The references are considered combinable as they are related to treating materials while still inside the egg. Hansen clearly teaches agitation through a hole in which the materials of the egg are maintained within the egg. This is considered a teaching that renders the claimed limitation of agitating through a hole obvious.

34. In response to applicant's arguments with regards to amended claims 4, 11 and 12, that prior art does not disclose or suggest the injecting an edible composition into a raw egg that includes grains, fruits, vitamins as recited in the instant claims 4, 11 and 12, Examiner disagrees. Examiner considers liquid flavouring of '299 Hongqi to encompass "edible material" food liquid flavoring comprising such flavors from alcohol (grains), fruit juices (fruit and vitamins), honey or liquid sweeteners (carbohydrates), and oleoresin (edible pigments). Any known edible material would have been obvious given the teachings of Hongqi.

35. In response to applicant's arguments that Yasushi does not mention agitating with an agitating means, Examiner agrees. However, Yasushi Chikako, JP 61-141864 is relied on the teaching of known in the art to withdraw contents including albumin and/or yolk followed by the addition of edible materials to the shell of the egg through a hole in the shell. The combined prior references commensurate the scope of the instant claims. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

36. In response to applicant's arguments to new claim 13, that '299 Hongqi does not suggest cleaning and sterilizing step before forming an injection hole, Examiner agrees. However, it is well known in the art of manufacturing that Good Manufacturing Practice Regulations under the authority of Federal Food, Drug and Cosmetic Act to ensure sanitation and cleanliness to minimize or eliminate contamination in raw material food ingredients, such as egg. It would have been obvious to one of ordinary skill in the art to clean and sterilize the egg before further processing, since it is a known and regulated practice in the food industry.

***Conclusion***

37. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HONG MEHTA whose telephone number is (571)270-7093. The examiner can normally be reached on Monday thru Thursday, from 7:30 am to 4:30 pm EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on 571-272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Htm

/Jennifer McNeil/  
Supervisory Patent Examiner, Art Unit 1794